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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,806	07/02/2003	Allon G. Engelman	247079-000208USPT	5370
70/243 7590 11/12/2009 NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606				
EXAMINER				
HSU, RYAN				
ART UNIT		PAPER NUMBER		
3714				
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11/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/612,806

Applicant(s)

ENGLMAN ET AL.

Examiner

RYAN HSU

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In response to the amendments filed on 4/29/09, claims 44 and 59 have been amended.

Claims 35-66 are pending in the current application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Peterson (US 2004/0048649 A1) and in view of Weingardt et al. (US 5,275,400)

Regarding claims 35, 40, 44, 49-51, 54 and 59, Peterson teaches a method of playing a progressive game which by definition provides accepting a player wager at a gaming terminal of a plurality of gaming terminals each of the plurality of gaming terminals being eligible for at least one progressive payoff and funding the progressive game payoff from a percentage of the player wagers, including the player wager, at the plurality of gaming terminals (*see paragraph [0025-0026], [0041]*). Additionally, Peterson teaches conducting a wagering game at a gaming terminal and achieving a progressive game entry award at the gaming terminal and activating the progressive game in response to achieving the progressive game entry award (*see paragraph [0035-0036]*). Furthermore, Peterson teaches displaying a plurality of player-selectable game elements during the progressive game including a first set of at least two elements associated with a progressive game payoff and a second, distinct set of elements, each being associated with a respective credit award (*see Fig. 4-6 and the respective related description thereof*). The

gaming system of Peterson teaches the selection of player inputs during the play of the bonus round (*ie: progressive game*) to provide selecting sequentially player-selectable game elements and awarding the progressive game payoff in response to a player selecting the first set of player-selectable game elements and awarding the respective credit award in response to the player selecting at least one of the second, distinct set of elements and receiving the award associated with the second distinct set of elements (*see paragraph [0037-0038], [0045-0050]*). . Additionally, Peterson teaches that the player selectable inputs could include various embodiments such as a concealed stop-game input or a wheel selection or other bonus games well known in the art (*see Fig. 4 and 6 and the related description thereof*). However, Peterson is silent with respect to specifically providing a player with two progressive prize selections in one round **but does teach that the plurality of player-selectable prizes** may include any combination of progressive prizes, credit awards, progressive free spins and etc. Peterson is also silent with respect to a second progressive prize being in larger value than that of the first progressive prize.

In an analogous gaming patent, Weingardt teaches providing different levels of progressive prizes and probabilities to users that play more per basic game of the gaming machine (*see Figs. 3-4 and the related description thereof*). Weingardt teaches that providing this feature would yield the predictable result of giving the players an incentive to wager more per game. Incorporating such teachings with that of Peterson would provide the expected result of providing different progressive prizes that could be available to the player produce the improvement of an exciting experience for the player for those that wager more and therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to

incorporate the feature of providing a player a larger prize if the player wagered more per play of the basic game.

Regarding claims 36 and 55, Peterson teaches a player-selectable game element including a continue-game element that allows for the continuation of the bonus game and a stop-game element that stops the bonus game and upon the receiving of a continue-game input providing the player with an award (*see Fig. 6 and the related description thereof*).

Regarding claims 37 and 45, Peterson teaches a method wherein the sequentially selecting one of the continue-game elements increases the bonus game payoff (*see Fig. 6-7 and the related description thereof*).

Regarding claims 38-39, 56 and 62-63, Peterson teaches a method wherein the bonus game includes a first and second game payoff wherein the second game payoff is higher than the first game payoff and selecting a predetermined number of continue-game elements or a predetermined number of level-increasing elements allow the player to achieve a second game payoff (*see Fig. 6 and the related description thereof*). Additionally, it is understood that in a progressive gaming environment that the bonus prizes are funded from a percentage of the player wagers from the plurality of gaming terminals.

Regarding claim 41, Peterson teaches a bonus game wherein a player selects from a plurality of bonus game qualifying items and they are displayed on the game machine display in order to determine the overall payoff for the user (*see Fig. 6 and the related description thereof*). However, Peterson is silent with respect to these qualifying items as been video envelopes. Video Envelopes in the instant invention simply act as item icons or display or theme art and do not would be a simply matter of design choice by the game programmer. As it would have been

obvious to one of ordinary skill in the art at the time the invention was made to incorporate a video envelope design into the player selectable components of Peterson's bonus game and expect the operation of the game to still meet the limitations of the instant invention.

Regarding claims 42, 48, and 58, Peterson teaches a method wherein the game includes first and second game payoffs and the first and second game payoffs are displayed on signage located above the gaming terminal (*see element [108a] of Fig. 4 and the related description thereof*). If the applicant's contends Peterson's ability to display the progressive bonus outputs the Examiner would like to enact OFFICIAL NOTICE that the display of awards on a signage display is extremely old and well known in the art. Furthermore, the Examiner cites the following references as examples of a signage device (**Okuda et al. (US 6,224,484 B1) - Figs. 2-3 and the related description thereof; Wood (US 5,286,023) -Figs. 1 and 6 and the related description thereof**).

Regarding claims 43, 57 and 65, Peterson teaches a method wherein the steps of conducting, achieving, activating, and displaying and determining a randomly selected outcome to be performed by a CPU internal or local to the gaming terminal (*see paragraph [0031]*).

Regarding claims 46-47 and 60-61, Peterson teaches a method wherein the gaming terminal includes a display and the display for displaying a plurality of player-selectable game elements and at least one player input corresponding to the one of the plurality of player-selectable game elements (*see paragraph [0048]*). Additionally, Peterson teaches the activation of a touch screen positioned over one of the plurality of player-selectable game elements (*see 'touch screen' and 'touch screen controller' paragraph [0032]*). Furthermore, the player

selectable elements when selected are opened to reveal an outcome (*see 'bonus game 4' Fig. 6 and the related description thereof*).

Regarding claims 52-53, Peterson teaches a method wherein the determining is performed by a CPU internal to the gaming terminal or external to the gaming terminal (*see paragraph [0031]*).

Regarding claim 64, Baerlocher teaches a continue-game element that includes a credit element the credit element provides the player of the bonus game with a credit award (*see [0037-0042], [0045-0050]*).

Regarding claim 66, Peterson teaches a gaming system that allows a player to be offered a progressive game payoff. Peterson teaches gaming terminal that includes a connection port (*see paragraph [0033]*).

Response to Arguments

1. Applicant's arguments with respect to claims 44-66 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached at (571)-272-4437.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH

November 9, 2009

/John M Hotaling II/

Primary Examiner, Art Unit 3714